

1746

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	Group Art Unit: 1746
John A. Reeve)	
Serial Number: 10/052,002)	Examiner: Alexander Markoff
Filed: January 17, 2002)	
Title: TREATMENTS OF SOLID)	Response Under Rule
SUBSTRATES TO ENHANCE)	37 CFR §1.111
DURABILITY OF TREATMENTS)	
PLACED THEREON)	
Attorney Docket: MAC – 199)	December 22, 2004

Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

In response to the office action mailed October 4, 2004, the applicant respectfully requests reconsideration of this application on the basis of the following remarks.

REMARKS

The applicant has studied the Examiner's action and notes that the claims in the case are claims 1 to 29 and that the Examiner has required a restriction of the claims to Group I, claims 1, 2, 7, 8, and 13 to 29; Group II, claims 3, 4, 11, and 12; and Group III, claims 5, 6, 9 and 10. During a telephone conversation, the applicant made a provisional election of Group 1, claims 1, 2, 7, 8, and 13 to 29 and applicant hereby confirms that election without traverse. Claims 3 to 6, and 9 to 12 have been withdrawn from further consideration by the Examiner.

Claims 1, 2, 7, 8, and 13 to 29 are drawn to a method of modification of substrates.

The Examiner has rejected these claims under 35 USC 112, first paragraph because the specification, while being enabling for the specific substrates, specific silicon

containing material and specific dianions, does not reasonably prove enablement for any non-specified substrates, materials and dianions.

The Examiner states that "The claims recite contacting of n on specified substrates with a silicon-containing material capable of reacting at or near the surface. The claims do not specify the "reacting". The claims do not recite with what the material should be capable of reacting. The claims do not even require the reacting."

The applicant would state for the Examiner that it is not required under the law to recite every nuance of the claimed invention in the specification. Applicant would remind the Examiner that the claim is directed to a method of "treating" a solid substrate, not "reacting" with a solid substrate. Further, there is no requirement in the claim that anything react with the substrate, it only states that the silicon-containing material is capable of reacting at or near the solid substrate surface.

With regard to this requirement, it is known that certain hydrolyzable silicones/silanes will react in the presence of water and that they co-condense to form polymeric networks. This is evidenced, in part, by the disclosure in the U.S. patents cited by the Examiner. Further, it can be observed from the same disclosures (and others too numerous to mention) that the silicon-containing materials can react with functional surfaces, such as cellulose, silicas and the like. Thus, the precise language of the claims accounts for both of these situations.

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." "A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1986); *Hybritech Inc. v Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The prior art is replete with examples of the use of silicon-containing materials on a variety of substrates and this does not have to be taught to the ordinary artisan and therefore, there is no need for undue experimentation.

The essence of the instant invention is the use of dianions in the treatment and the Examiner has not found any art that would cause the applicant to limit the claims.

Finally, the Examiner complains that "The specification discloses only antimicrobial treatment of the specific substrates with specific antimicrobial agents and that there is no disclosure or teaching regarding other treatments presented in the specification", and that, "The specification provides no guidance how other treatments of different substrates can be determined." "Without such guidance (the examiner states) an ordinary artisan would not be able to practice the invention without undue experimentation".

The applicant would direct the Examiner's attention to the M.P.E.P, Section 2164.01(c), page 2100-187, first column, last paragraph wherein it is stated: "In contrast, when a compound or composition claim is not limited by a recited use, any enabling use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for non-enablement based on how to use. If multiple uses for claimed compounds or compositions are disclosed in the application, then an enablement rejection must include an explanation, sufficiently supported by the evidence, why the specification fails to enable each disclosed use. In other words, if any use is enabled when multiple uses are disclosed, the application is enabling for the claimed invention. (emphasis applicant's)."

The aforementioned remarks apply equally well to the rejection of the claims under 35 USC 112, second paragraph.

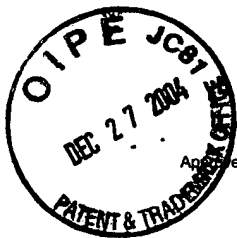
The prior art cited by the Examiner is noted of interest.

The applicant respectfully requests a withdrawal of the rejections and an allowance of the claims.

Respectfully submitted,



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For USSN 10/052,002 in the name of John A. Reeve, entitled: TREATMENTS OF SOLID SUBSTRATES TO ENHANCE DURABILITY OF TREATMENTS PLACED THEREON, Response Under Rule 1.111 consisting of 3 pages, return receipt postcard, via US Mail on December 23, 2004.

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